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EXPRESS MAIL NO.: GB 624 977 518 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Burrell et al.

Application No.: 08/284,199

Group Art Unit: 1803

Filed: August 2, 1994

Examiner: D. FOX

For: MODIFICATION OF PLANT
METABOLISM

Attorney Docket No.: 9341-005

104,046
#21

INFORMATION DISCLOSURE STATEMENT

FYI

Assistant Commissioner for Patents
Washington, D.C. 20231

OCT 06 1997

RECEIVED IN
BOX INTERFERENCE

Sir:

In compliance with the duty under 37 C.F.R. § 1.56 to inform the Patent Office of all information and references coming to the attention of Applicants or attorneys for Applicants which are or may be material to the patentability of any claim of the instant application, Applicants and attorneys for Applicants hereby direct the Examiner's attention to references AA-AB listed on the attached revised PTO Form PTO-1449 entitled "List of References Cited by Applicant". Copies of references AA-AB are enclosed herewith.

Identification of the listed references is not to be construed an admission of Applicants or attorneys for Applicants that such references are available as "prior art" against the instant application. Further, Applicants believe that the invention claimed in the instant application is patentable over the cited references.

Applicants invite the Examiner's attention to the following two references: Sweetlove et al., 1996, Biochem. J. 320:487-492 ("Sweetlove I"; reference AA); and

Sweetlove et al., 1996, Biochem. J. 320:493-498 ("Sweetlove II"; reference AB).

Sweetlove I discloses the production of transgenic potato plants containing and expressing a chimeric gene comprising a patatin promoter operably linked to an *E. coli glgC-16* adenosine diphosphoglucose pyrophosphorylase (ADPGPP) coding sequence. The *glgC-16*-expressing transgenic plants were produced by transforming potato variety Prairie with *Agrobacterium* transformation vector pFW4173 containing the aforementioned chimeric gene. Sweetlove I reports that tubers from *glgC-16*-expressing transgenic plants have significantly higher ADPGPP activity than tubers from control plants. Sweetlove II reports that notwithstanding their higher ADPGPP activity, tubers from *glgC-16*-expressing transgenic plants have starch content not significantly different from those of tubers from control plants (see Sweetlove II, first and second paragraphs at page 495, and Tables 1 and 3). Michael M. Burrell ("Dr. Burrell"), the inventor of the present application, is a co-author of both Sweetlove I and II.

On March 5, 1993, Applicants submitted a declaration of Dr. Burrell in connection with Application No. 07/991,451 (the "'451 application"). The present application is a continuation of the '451 application. At the request of the Examiner (see Office Action dated April 28, 1995), Applicants submitted on October 30, 1995 a copy of Dr. Burrell's declaration and made it of record in the file of the present application.


In the March 5, 1993 declaration, Dr. Burrell stated that he had produced or had had others produce *glgC-16*-expressing transgenic potato plants by carrying out *Agrobacterium* transformation of potato variety Prairie. The transformation was carried out using plasmid pFW4173, which contained a chimeric gene comprising a patatin promoter and an *E. coli Glg C₁₆* (i.e., *glgC-16*) ADPGPP coding sequence. Dr. Burrell stated that examination of tubers from *glgC-16*-expressing transgenic plants showed that they have more starch than tubers from control plants.

Applicants respectfully invite the Examiner's attention to the accompanying Declaration of Michael M. Burrell. In this declaration, Dr. Burrell states that the findings reported in the earlier declaration and those reported in Sweetlove I and II were based the same experiments, but that the findings reported in the earlier declaration were based on analysis of results from partially-completed, greenhouse experiments. Dr. Burrell states that results from the completed experiments and additional, subsequent greenhouse and field experiments show that tubers from *glgC-16*-expressing transgenic potato plants do not have significantly more starch than tubers from control plants. Accordingly, Dr. Burrell concludes that the findings stated in his earlier declaration regarding the effect of expressing *glgC-16* ADPGPP on the starch content of potato tubers are inconsistent with those stated by the Sweetlove II. Applicants' attorneys will address Sweetlove II in more detail when *ex parte* prosecution of the instant application resumes.

The fee required for this submission is estimated to be \$240.00. Please charge the required fee to Pennie & Edmonds LLP deposit account no. 16-1150. A duplicate copy is enclosed for accounting purposes.

Respectfully submitted,

Date: October 5, 1998

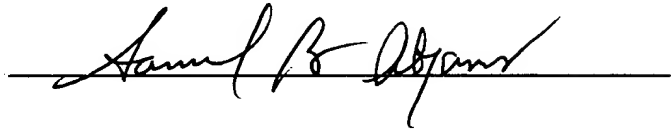

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CERTIFICATE OF SERVICE

I hereby certify that on this 5th date of October 1998, a true copy of the foregoing **INFORMATION DISCLOSURE STATEMENT** was mailed by overnight mail, postage prepaid, to counsel for the party KISHORE.

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A handwritten signature in cursive script, appearing to read "Samuel B. Adams", is written over a horizontal line.